

REMARKS

The Office Action dated March 30, 2004, has been received and reviewed.

Claims 1-6, 8-30, 42-49, and 75-88 are currently pending and under consideration in the above-referenced application. Claims 1-6, 8, 10-19, 21-30, 42-49, 75-77, 79, 81-84, 86, and 88 stand rejected. Claims 9, 20, 78, 80, 85, and 87 have been objected to for depending from rejected base claims.

New claims 98-103 have been added.

Reconsideration of the above-referenced application is respectfully requested.

Rejections Under 35 U.S.C. § 103(a)

Claims 1-6, 8, 10-19, 21-30, 42-49, 75-77, 79, 81-84, 86, and 88 stand rejected under 35 U.S.C. § 103(a).

The standard for establishing and maintaining a rejection under 35 U.S.C. § 103(a) is set forth in M.P.E.P. § 706.02(j), which provides:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Anderson in View of Kofoed and Orr

Claims 1-6, 8, 10-19, 21-30, 42-49, 75-77, 79, 81-84, 86, and 88 stand rejected under 35 U.S.C. § 103(a) for being drawn to subject matter which is purportedly unpatentable over the subject matter taught in U.S. Patent 4,440,177 to Anderson et al. (hereinafter “Anderson”), in view of teachings from U.S. Patent 5,379,650 to Kofoed et al. (hereinafter “Kofoed”) and, further, in view of the subject matter taught in U.S. Patent 6,475,158 to Orr et al. (hereinafter “Orr”).

Orr is relied upon for its teaching that “a luminescence quenching sensor is a known oxygen monitoring sensor.” Office Action of March 30, 2004, page 2. It is respectfully submitted that this teaching from Orr is not prior art to any of claims of the above-referenced application.

Notably, independent claim 1 is the only independent claim of the above-referenced application that is limited to a component that comprises at least one “luminescence quenching sensor.” None of independent claims 22, 42, 75, or 82, or several of the claims that depend therefrom, is limited to an apparatus that includes a “luminescence quenching sensor.” Instead, the apparatus of independent claim 22 includes a component that is configured to employ “luminescence quenching techniques,” while the apparatus of independent claims 42, 75, and 82 merely include “luminescable material.” Further, none of these claims limits use of luminescence quenching or the luminescable material to use in monitoring oxygen.

In the above-referenced application, a claim has been made for the benefit of priority to the filing dates of U.S. Application Serial Nos. 09/128,897 (hereinafter “the ‘897 Application”) and 09/128,918 (hereinafter “the 918 Application”), both of which disclose the use of luminescence quenching sensors in oxygen monitoring. Both of these applications were filed on August 4, 1998. Orr was not filed until October 24, 2000—more than two years after the August 4, 1998, priority date for this subject matter of the above-referenced application.

Therefore, Orr does not qualify under any subsection of 35 U.S.C. § 102 as prior art to any recitation in the claims of the above-referenced application pertaining to apparatus that include components that employ luminescence quenching techniques or that include luminescable material, as disclosed in the ‘897 Application or the ‘918 Application.

As indicated in the outstanding Office Action, neither Anderson nor Kofoed includes any teaching or suggestion of an apparatus that includes luminescable material or that employs luminescence quenching techniques.

Therefore, each of claims 1, 42, 75, and 82, as well as dependent claims 2-6, 8, 10-19, 21-30, 42-49, 75-77, 79, 81-84, 86, and 88 recites subject matter which, under 35 U.S.C. § 103(a), is allowable over the subject matter taught in Anderson, Kofoed, and Orr.

Accordingly, withdrawal of the 35 U.S.C. § 103(a) rejections of claims 1-6, 8, 10-19, 21-30, 42-49, 75-77, 79, 81-84, 86, and 88 is respectfully requested.

Anderson in View of Kofoed and Blazewicz

Claims 1-6, 8, 10-19, 21-30, 42-49, 75-77, 79, 81-84, 86, and 88 stand rejected under 35 U.S.C. § 103(a) for reciting subject matter which is allegedly unpatentable over the teachings of Anderson, in view of teachings from Kofoed and, further, in view of the subject matter taught in U.S. Patent 6,632,402 to Blazewicz et al. (hereinafter “Blazewicz”).

Blazewicz is relied upon for its teaching of apparatus that include luminescence quenching sensors and luminescable materials. Office Action of March 30, 2004, pages 3-4.

There are several reasons that Blazewicz does not qualify or cannot be used as prior art to the subject matter recited in any of claims 1-6, 8, 10-19, 21-30, 42-49, 75-77, 79, 81-84, 86, and 88.

First, the above-referenced application also claims the benefit of priority to the August 4, 1998, filing dates of the ‘897 and ‘918 Applications, both of which disclose apparatus that include luminescable material and apparatus that employ luminescence quenching. Blazewicz issued from an application that was not filed until January 24, 2001, and, therefore, does not qualify as prior art to the above-referenced application under any subsection of 35 U.S.C. § 102.

Second, the above-referenced application has a filing date of April 24, 2001, which follows the January 24, 2001, date on which the application that issued as Blazewicz was filed, but precedes the October 14, 2003, issue date of Blazewicz. Therefore, the above-referenced application is subject to the provisions of 35 U.S.C. § 103(c).

With respect to rejections under 35 U.S.C. § 103(a) that are based upon references which qualify as prior art under 35 U.S.C. § 102(e), 35 U.S.C. § 103(c) provides:

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

M.P.E.P. § 706.02(l)(3) explains that the evidentiary burden of the requirement that the subject matter and claimed invention be, “at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person” is met merely by a statement to that effect:

Applications and patents will be considered to be owned by, or subject to an obligation of assignment to, the same person, at the time the invention was made, if the applicant(s) or an attorney or agent of record makes a statement to the effect that the application and the reference were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same person(s) or organization(s).

See also M.P.E.P. § 706.02(l)(2)

Only in the rare instance that the examiner “may have independent evidence that raises a material doubt as to the accuracy of applicant’s representation of either (1) the common ownership or, or (2) the existence of an obligation to commonly assign, the application being examined and the applied U.S. patent or U.S. patent application publication reference” may the examiner “require objective evidence of common ownership of, or the existence of an obligation to assign, the application being examined application and the applied reference as of the date of invention of the application being examined.” M.P.E.P. § 706.02(l)(2).

M.P.E.P. § 706.02(l)(1) indicates that 35 U.S.C. 103(c) applies to all applications which have filing or priority dates of November 29, 1999, or later:

This change to 35 U.S.C. 103(c) applies to all utility, design and plant patent applications filed on or after November 29, 1999, including continuing applications filed under 37 CFR 1.53(b),

continued prosecution applications filed under 37 CFR 1.53(d),
and reissues.

At the time the inventions recited in the claims of the above-referenced application and in Blazewicz was made, they were owned by or subject to an obligation of assignment to NTC Technology Inc., as evidenced by the assignment recorded at Reel No. 14262, Frame No. 0180. NTC Technology Inc. is the same party to which Blazewicz had already been assigned, as indicated by the cover sheet of Blazewicz.

Accordingly, Blazewicz may not be relied upon in a rejection of any of the claims of the above-referenced application under 35 U.S.C. § 103(a).

As indicated in the outstanding Office Action, neither Anderson nor Kofoed includes any teaching or suggestion of an apparatus that includes luminescable material or that employs luminescence quenching techniques.

In view of the foregoing, it is respectfully requested that the 35 U.S.C. § 103(a) rejections of claims 1-6, 8, 10-19, 21-30, 42-49, 75-77, 79, 81-84, 86, and 88 is respectfully requested.

Allowable Subject Matter

The indication that claims 9, 20, 78, 80, 85, and 87 recite allowable subject matter is gratefully acknowledged. The subject matter recited in each of these claims has been incorporated into new independent claims 98-103, respectively.

CONCLUSION

It is respectfully submitted that each of claims 1-6, 8-30, 42-49, 75-88, and 98-103 is allowable. An early notice of the allowability of each of these claims is respectfully solicited, as is an indication that the above-referenced application has been passed for issuance. If any issues preventing allowance of the above-referenced application remain which might be resolved by way of a telephone conference, the Office is kindly invited to contact the undersigned attorney.

Respectfully submitted,



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